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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/449,159 | 11/24/1999 | SHAWN D. ABBOTT | 30074.26US11 | 5935 |

22462 7590 03/09/2005

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| EXAMINER | |
|---|---|
| JACKSON, JENISE E | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2131 | |

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/449,159 | ABBOTT ET AL. | |
| | Examiner | Art Unit | |
| | Jenise E Jackson | 2131 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,2,4-15,18-31,34-46,49-54,56-77,80-87 and 89* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *51,52 and 58-60* is/are allowed.

6)☒ Claim(s) *1,2,4-15,18-31,34-46,49,50,54,56,57,61-77,80-87 and 89* is/are rejected.

7)☒ Claim(s) *63* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-2, 4-6, 18, 35, 38-40, 49-50, 54, 56-57, 61-62, 65-66, 71, 73, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rallis(6,425,084) in view of Molva(5,347,580).

3. As per claims 1, 18, 35, 49, 54, 61, 71, 86, Rallis et al. discloses compact personal token(20)(see fig. 1B, sheet 1), a USB-compliant interface releaseably(14) coupleable to a host processing device(10)(see fig. 1A, sheet 1); a token memory; a processor, communicatively coupled to the memory and communicatively, coupleable to the host processing device via the USB-compliant interface(see fig. 1A, 1B, sheet 1, col. 3, lines 4-17), the token processor for providing the host processing device conditional access to data storable in the memory(see col. 2, lines 58-66); and a user input device, communicatively coupled to the processor by a path distinct from the USB-compliant interface, for accepting an input signaling authorization of a processor operation(see col. 2, lines 63-67, fig. 1A, sheet 1). The Examiner asserts that access to private data is secured, because only the authorized user with the Pin can access the host computer system. Rallis does not disclose "for processing by the processor to signal authorization of a processor operation providing access to the user private data", "in response to a message received in the token from the host processing device via the USB-compliant interface

invoking the processor operation". The Examiner asserts that Rallis does disclose this, because Rallis discloses power and command messages from the notebook computer that contains a processor, and response messages from the key device(see col. 2, lines 1, lines 46-58). The Examiner asserts that the user private data of the notebook computer is not allowed to be accessed, until the user is validated, because Rallis discloses the key device is used in conjunction with the notebook computer to prevent unauthorized user's from gaining access to the notebook computer(see col. 2, lines 58-66). Rallis is silent on wherein user authentication occurs on the token. However, Molva discloses wherein the user authentication occurs on the token(see col. 4, lines 56-64). It would have been obvious to one of ordinary skill in the art at the time of the invention to include user authentication occurs on the token of Molva with Rallis, the motivation is that the smartcard containing information that is used to authenticate the user reduces the user's ability to change his secrets with the ability to update the card's storage(see col. 4, lines 62-64).

4. As per claims 2, 38, Rallis discloses wherein the path is entirely internal to the token(see col. 1, lines 62-67).

5. As per claim 4, Rallis discloses wherein the private data is designated as requiring authorization before access by an associated identification stored in the memory(see col. 1, lines 61-67, col. 2, lines 62-66).

6. As per claims 5, 39, 65, 73, Rallis discloses wherein the input device includes at least one pressure-sensitive device actuatable from an exterior surface of the token(see col. 5, lines 46-50).

7. As per claims 6, 40, 66, Rallis et al. discloses wherein the input device comprises at least one push-button switch(see col. 5, lines 46-50).

8. As per claims 50, 57, Rallis et al. inherently discloses wherein the user input device includes a character input device, because Rallis discloses a user has to enter a pin(see col. 1, lines 62-67).

9. As per claim 62, Rallis et al. discloses wherein the user input device is configured to control an operation of the processor(see col. 2, lines 59-67) .

10. As per claim 56, Rallis discloses, wherein the user output device is coupled to the processor by a path distinct from the USB-compliant interface(see col. 6, lines 7-22).

11. As per claim 86, Rallis discloses authorizing access to private data stored in a token having a processor communicatively coupleable to a host processor via a Universal Serial Bus (USB) interface, comprising the steps of: accepting a command in the token invoking a processor operation; and signaling the processor operation via a user output device(see col. 1, lines 62-67, col. 2, lines 62-66, see fig. 1A, sheet 1).

12. Claims 7-10, 12-15, 19-26, 28-31, 34, 36-37, 41, 43-46, 63-64, 67-69, 72, 74-77, 80-83, 85, 87, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rallis-Molva et al in view of Kobielus.

13. Claims 7, 74, 81, 82, Rallis-Molva combination does not disclose an output device, coupled to the processor by a second path distinct from the USB-compliant interface, for prompting a user to provide an authorization of a processor operation. Kobielus teaches the output device that is the LCD. The Examiner asserts that it is a path distinct from the USB-compliant interface, because Rallis discloses the USB-compliant interface that has a USB port is located on the computer(see fig. 1A, sheet 1). The LCD of Kobielus it taught as being on the token.

14. It would have been obvious to one of ordinary skill in the art to combine Rallis-Molva with Kobielus, because both are analogous for providing a token to a user in order to gain access to computer. The motivation to include an output device such as a LCD is, the LCD display's the access code in Kobielus. Kobielus discloses that SecurID does a challenge and response process that generates an access code, and the user entered the pin plus the access code that is displayed on the token's LCD.

15. The same motivation applies above, same motivation applies above, the Examiner asserts that in regards to claims 8, 21, 36, and 75, the path and the second path are a common path, because the paths work together in order to communicate(see Rallis and Kobielus).

16. Claims 9, 19, 77, and 80, 10, 12, 28, 41, 43, 67, 68-69, 76, 89, Rallis-Molva is silent for output device. However, Kobielus teaches an output device, such as a LCD. It would have been obvious to one of ordinary skill in the art to combine Rallis with Kobielus, because both are analogous for providing a token to a user in order to gain access to computer. The motivation to include an output device such as a LCD is, the LCD display's the access code in Kobielus. Kobielus discloses that SecurID does a challenge and response process, that generates an access code, and the user entered the pin plus the access code that is displayed on the token's LCD.

17. As per claim 20, Rallis discloses wherein the output device is communicatively coupled to the processor by a second communication path distinct from the USB-compliant interface (see fig. 1A, sheet 1).

18. As per claim 23, Rallis discloses wherein the path is entirely internal to the token(see col. 1, lines 62-67).

19. As per claim 24, Rallis discloses wherein the input device includes at least one pressure-sensitive device actuatable from an exterior surface of the token(see col. 5, lines 46-50).

20. As per claim 25, Rallis et al. discloses wherein the input device comprises at least one push-button switch(see col. 5, lines 46-50).

21. Claims 11, 27, 42, and 70, 84, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rallis-Molva et al in view of Kobielus and further in view of Smith et al.

22. As per claims 11, 27, 42, 70, 84 Rallis-Molva nor Kobielus does not disclose an aural device. However, Smith et al. discloses an aural device(see col. 2, lines 32-36). It would have been obvious to modify Rallis-Molva and Kobielus with Smith, because Smith et al. discloses a buzzer that is designed to warn the user of imminent interruption of power(see col. 2, lines 32-36). Thus, an aural device is a warning signal to warn the user of activity.

23. Claims 13, 22, 26, 29, and 34, 44, 14, 30, 37, 45, 15, 31, 46, Rallis-Molva does not disclose a private key. However, Kobielus teaches a private key. Both Rallis-Molva and Kobeilus are analogous in the art of token's. It would have been obvious to one of ordinary skill in the art to modify Rallis with Kobeilus, because Kobelius teaches the token uses a secret algorithm and key to produce a onetime, nonrepeatable session password that is displayed on the LCD(output). The Examiner asserts that by using a secret algorithm that is changed every minute is more secure.

24. Claims 63, 72, 83, 87, Rallis-Molva does not disclose an encryption and decryption. However, Kobielus discloses encryption and decryption. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rallis-Molva with Kobielus, because Kobielus teaches that a token can contain a digital signature that is hashed and encrypted

with the originator's private key production the digital signature string that is then attached to and transmitted with the original object, along with a public key that can be used to validate it. The recipient can verify the digital signature by decrypting it with the originator's public key.

25. Claim 64, Rallis-Molva does not disclose a digital signature. However, Kobielus teaches a digital signature. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rallis-Molva with Kobielus, because Kobielus teaches that a digital signature authenticates the originator of an object and attests to the fact that the object has not been altered.

26. As per claim 85, Rallis discloses further comprising an input device, communicatively coupled to the processor by path distinct from the USB-compliant interface, for providing information for the operation of the processor(see fig. 1A, sheet 1).

27. As per claims 51-52, 58-60 are allowable because, in prior art there is no token or key that contains a wheel that a user can select to input characters, there is also no prior art that discloses two pressure sensitive devices in order to input characters. As per claim 53 is objected to as being rejected on base claim 49, for the same reason above.

***Response***

28. The Applicant has amended independent claims to include, wherein the user authentication occurs on the token(please see above for explanation).

29. Claim 53 is still objected to as being rejected on base claim 49.

limitation.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 5, 2005

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